Appl. No. 10/705,212
Amdt. dated July 7, 2009
Amendment
Examining Group 3621

PATENT

REMARKS/ARGUMENTS

Prior to this amendment, claims 1-8, 10-17, 19-26, 28-38 and 41-44 were pending. In this amendment, claims 1, 5, 6, 10, 14, 15, 17, 19, 23, 24,30, and 43 are amended, claims 4, 13, 22, 34-37, and 42 are canceled and claims 45 and 46 are added. No new matter is added. Thus, after entry of this amendment, claims 1-3, 5-8, 10-12, 14-17, 19-21, 23-26, 28-33, 41, and 43-46 are pending.

I.   Claim Rejections – 35 USC § 112, First Paragraph

Claims 1-8, 10-17, 19-26, 28-38, and 41-44 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection is traversed. The Office Action alleges that claim 1 recites "*wherein the authentication response includes a second HTTP redirect command comprising the address of the merchant, wherein the cardholder system thereafter forwards the authentication response to the merchant system*" which lacks support in the specification. (Office Action Pg. 4).

With respect to the first feature, "*wherein the authentication response includes a second HTTP redirect command comprising the address of the merchant,*" the claims have been amended to more clearly recite this feature as disclosed in the specification. As such, the rejection related to this claim feature is moot.

With respect to the second feature, "*wherein the cardholder system thereafter forwards the authentication response to the merchant system,*" support for this feature can be found in the second sentence of P[0036] of the specification as filed, which recites, "*The cardholder system 205 in turn forwards the authentication response 268 back to the merchant system 210.*"

Withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is respectfully requested for the reasons mentioned above.

II.   Claim Rejections – 35 USC §103(a), Sunder, Breck, Graves

Claims 1, 2, 7, 8, 10, 11, 16, 17, 19, 20, 25, 26, 32, 33, 38, 41, 43, and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Sunder* (U.S. Patent Pub. No. 2005/0021781) and *Breck* (U.S. Patent Pub. No. 2004/0158532) in view of *Graves* (U.S. Patent Pub. No. 2004/0177047). This rejection is traversed. In the interests of advancing prosecution, independent claim 1 has been amended to incorporate the limitations of dependent claims 3 and 4. Claim 3 was rejected as being obvious over *Sunder, Breck, and Graves* in further view of *Gerdes* (U.S. Publication No. 2003/0046541). Claim 4 was rejected as being obvious over *Sunder, Breck, and Graves* in further view of *Golan* (U.S. Publication No. 2004/0254848). Independent claims 10 and 19 have also been amended to recite limitations that are similar to those in claim 1.

As such, the rejection of independent claims 1, 10, and 19 is now in view of <u>five</u> references, *Sunder, Breck, Graves, Gerdes,* and *Golan.* The citation of <u>five</u> references to reject the broadest claims suggests that impermissible hindsight was used.

There are a number of additional reasons why the claims are patentable. First, there would be no rational underpinning to combine the cited references. Second, the combination of references as suggested by the Office Action would alter the principle of operation of the primary reference. Finally, even if there was a rational underpinning to the combine these five references, each and every limitation of the claims is not taught or suggested by the references..

A.   *No Rational Underpinning to Combine References*

Sunder describes a system of providing data to a client device by a network access point. (*Sunder,* Abstract). The client device may send an authentication request to a network access point, the authentication request including identification credentials. (*Sunder*, P[0007]). The network access point may communicate the authentication request to an authentication server. (*Sunder*, P[0008]). The authentication server may create an authentication response, including data such as pricing details for utilizing the network access point. (*Sunder*, P[0062]). The authentication response may be sent to the client device via the network access point. (*Sunder*,

P[0063-0064]). The client device may parse the authentication response to determine network access point details, such as pricing for using the network access point. (Id.). *Sunder* does not disclose or suggest a merchant system. The Office Action admits *Sunder* does not disclose or suggest a merchant system. (Office Action, Pg. 4-5).

The Office Action relies on *Breck* as disclosing a merchant system. (Office Action, Pg. 4-5). *Breck* describes a system wherein a user submits a secondary transaction number (STN) that is associated with the user's primary account to a merchant system. (*Breck*, Abstract). When making a purchase on the merchant's system, the user may click a link to retrieve a STN. (*Breck*, P[0080]). The STN may be utilized to complete a purchase on the merchant's web site, thus relieving the user of having to disclose his real account number to the merchant. (*Breck*, P[0014]).

Although *Breck* may describe a merchant system, there would be no reason to include a merchant system in the system of *Sunder*. The system in *Sunder* allows a client device to obtain network access point information, such as pricing information, from an authentication server. There would be no reason to add a merchant system to the system as described in *Sunder*, as a merchant system would serve no purpose in the system as described in *Sunder*. The Office Action has alleged that one of skill in the art would have been motivated to combine *Sunder* and *Breck* as it would provide an additional level of security. (Office Action, Pg. 6). The Office Action not only fails to set forth a purpose, other than a conclusory statement not supported by evidence, for adding a merchant system to *Sunder*, it also fails to articulate how adding a merchant system, which would serve no purpose in *Sunder*, provides any additional security. Even if a merchant system was added to the system in *Sunder*, it would actually decrease security, as it would be an additional system that contains data that could be compromised.

The Office Action further relies on *Graves* as disclosing or suggesting a merchant system. *Graves* describes a system wherein a buyer may make a purchase from a seller online. (*Graves,* Abstract). The buyer may send authentication information to an authentication service. (*Graves,* P[0052]). The authentication service may present a challenge to the buyer. (Id.). If the

authentication service receives a proper response from the buyer, the authentication service notifies the seller system that the transaction is authorized. (*Graves*, P[0056]).

Once again, for the same reasons as discussed above with respect to *Breck*, *Graves* at best describes a merchant system. However, this still does not resolve the issue that there would be no reason to add a merchant system to *Sunder*, as it would serve no purpose in transferring information from the authentication server to the client device. Additionally, just as with *Breck*, there would be no additional security provided by adding a merchant server that serves no purpose, to *Sunder*.

The Office Action has not articulated any reasonable reason why a merchant system would be added to the system as described in *Sunder*. As such, it appears the only reason for adding a merchant system to *Sunder* is in view of the Applicants' disclosure. As such, the Office Action is using impermissible hindsight to combine the references. Applicants understand that there need not be an express reason to combine references stated in the references, however there must be some reason a person of skill in the art would be motivated to do so, at the time of invention. See MPEP 2145(X)(A).

Golan describes a system wherein a merchant queries a directory server with a verifying enrollment request to determine if the cardholder is enrolled in the authentication system. (*Golan*, P[0094]). The directory server queries an access control server (ACS) to determine if the cardholder is enrolled, and if so, the ACS returns a URL for the ACS which can be returned to the merchant system. (*Golan*, P[0096-0097]). The merchant system may then send the URL to the cardholder system in a web page that redirects the cardholder system to the ACS. (*Golan*, P[0099]).

The combination of *Golan* with *Sunder* is improper for at least the reasons described above. There would be no reason to add a directory server to *Sunder*, as it would serve no purpose. The system in *Sunder* does not require a directory server for operation, and the only reason to add a directory server would be impermissible hindsight.

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B.   ***Proposed Modification Changes Principle Mode of Operation of the Reference***

The proposed combination of references changes the principle mode of operation of the primary reference.

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.). MPEP 2143.01(VI).

As stated above in MPEP 2143.01(VI), if the proposed modification of a reference changes the principle of operation of the prior art, the teachings of the references are not sufficient to render the claims *prima facie* obvious. Here, the Office Action is not suggesting a proposed modification to a merchant system in *Sunder,* but rather the Office Action is adding a completely unnecessary element, the merchant system, to *Sunder.* The *Sunder* reference does not need a merchant server for operation. The addition of a merchant server would alter the principle mode of operation of *Sunder* by adding an element that would serve no purpose in enhancing the operation of *Sunder*.

Similarly, just as above, the addition of *Golan* alters the principle of operation of *Sunder*. *Sunder* does not require nor suggest a directory server because such a server is not necessary for the principle mode of operation of *Sunder*. The addition of *Golan* does not merely modify the *Sunder* reference, but rather adds an element, the directory server, that is entirely unnecessary to the principle mode of operation of *Sunder*.

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C. *Each and Every Limitation is not Disclosed by the References, Alone or in Combination*

Each and every limitation of the claims is not taught or suggested by the references, alone or in combination. For example, claim 1 as amended, recites in part, a merchant server that:

> receives a verifying enrollment response from the directory server, the verifying enrollment response including a web site hosted by a central transaction server, the verifying enrollment response further including a pseudonym corresponding to the electronic commerce card account number, the pseudonym expiring after a predetermined period of time;
>
> and
>
> sends an authentication request to a cardholder system in a web page having an HTTP redirect command comprising the web site hosted by the central transaction server, the web page further including a URL for returning information to the merchant system, the authentication request including the pseudonym corresponding to the electronic commerce card account number;

(*emphasis added*). Such a limitation is not disclosed or suggested by *Sunder, Breck,* or *Graves,* alone or in combination. A similar limitation was previously present in claim 4, and has been incorporated into claim 1. In the rejection of claim 4, the Office Action has alleged that such a limitation is described by *Golan* (U.S. Publication No. 2004/0254848).

Even if such an improper combination was made, such a limitation would still not be taught or suggested by the combination of references. Claim 1 recites that the verifying enrollment response includes a web site hosted by the central transaction server. The merchant server then redirects the cardholder authentication request to the central transaction server. Claim 1 further recites a central transaction server that *"forwards the authentication request to an access control server." Golan* describes the verifying enrollment response including a URL of an access control server. (*Golan,* P[0096-0097]). The merchant server then redirects the cardholder to the access control server. (*Golan,* P[0098]). *Golan* does not disclose or suggest a central transaction server. If the central transaction server as described in claim 1 is equated with the access control server of *Golan,* a nonsensical result would be achieved, because it would require the access control server to forward the authentication request to itself.

Similarly, claim 1 recites a central transaction server that:

> receives the verifying enrollment request from the directory server;

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> sends the verifying enrollment response to the directory server;
> receives the authentication request from the cardholder system, at the web site
> hosted by the central transaction server in response to the HTTP
> redirect command sent by the merchant system to the cardholder
> system;
> forwards the authentication request to an access control server

Such limitations are not disclosed or suggested by *Sunder*. As explained above, the addition of *Golan* does not resolve this, as the combination of *Sunder* and *Golan* would require that the access control server, which has been equated to the central transaction server, forward authentication messages to itself.

Withdrawal of the rejection of claim 1, and the claims which depend therefrom, is respectfully requested. Claims 10 and 19 are amended to contain limitations that are also not disclosed or suggested by the cited references for reasons including those set forth above. Withdrawal of the rejections of claims 10 and 19, and the claims which depend therefrom, is respectfully requested.

III.   Claim Rejections – 35 USC §103(a), Sunder, Breck, [Graves], Gerdes

Claims 3, 12, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Sunder* and *Breck* as applied to claims 1, 10, and 19, in further view of *Gerdes* (U.S. Publication No. 2003/0046541). As claims 1, 10, and 19 were rejected under *Sunder, Breck,* and *Graves*, in the interests of advancing prosecution, Applicants will assume that the omission of the *Graves* reference was an oversight.

This rejection has been obviated by the incorporation of claims 3, 12, and 21 into their respective independent claims and the subsequent cancelation of the claims.

IV.   Claim Rejections – 35 USC §103(a), Sunder, Breck, [Graves], Golan

Claims 4-6, 13-15, 22-24, and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Sunder* and *Breck* as applied to claims 1, 10 in further view of *Golan*. As claims 1, and 10 were rejected under *Sunder, Breck,* and *Graves*, in the interests of advancing

prosecution, Applicants will assume that the omission of the *Graves* reference was an oversight. Furthermore, claims 22-24 depend from claim 19, which was rejected for reasons similar to the rejections of claims 1 and 10. In the interests of advancing prosecution, Applicants will assume that the omission of claim 19 was an oversight. This rejection is traversed.

Claims 4, 13, and 22 have been incorporated into their respective independent claims, and the rejections thereto have been addressed with respect to those independent claims. The remaining claims, 5, 6, 14, 15, 23, 24, and 28-31 are allowable at least by virtue of their dependence from their respective independent claims. Withdrawal of this rejection is respectfully requested.

V.   Claim Rejections – 35 USC §103(a), Sunder, Breck, [Graves], Golan

Claims 34-37 and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Sunder* and *Breck* in view of *Golan.* Claims 34-37 and 42 have been canceled, and as such the rejection of the claims is moot.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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